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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/642,932

08/18/2003

Nathan Eldon Nesbit

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7590

11/20/2006

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EXAMINER

DENG, ANNA CHEN

ART UNIT

PAPER NUMBER

2191

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/642,932

Applicant(s)

NESBIT ET AL.

Examiner

Anna Deng

Art Unit

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/1/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This action is in response to the application filed on 8/18/2003.
2. Claims 1-21 are pending.
3. Claims 1-21 have been examined.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-8 and 17-21 are rejected under 35 U.S.C. 101 because it appears to examiner that claims 1, 5 and 17 fail to result in a tangible and concrete result. Claim 1 set forth a method determining a test suite for a current software build, but there is no tangible and concrete result after the steps of determination. Claims 5 and 17 are similar to claim 1 except that they set forth a system (claim 5) and a medium (claim 7). A claim only has steps but no results is not directed to a practical application because the claim does not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result. As claims 1-8 and 17-21 are not limited to a practical application, the claims are non-statutory.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-21 are rejected under 35 U.S.C. 102 (e) as being anticipated by Ousterhout et al., US Patent Application Publication 2004/0194060 A1 (hereinafter Ousterhout).

**Per Claim 1:**

Ousterhout discloses:

- A method for determining a test suite for a current software build (paragraph 0037), comprising:
  - obtaining a current software build (Fig. 4a, paragraph 0040, lines 2-8);
  - obtaining a reference software build (Fig. 4a, 4c, paragraphs, 0053, 0058, lines 7-19, and 0063);
  - comparing the current software build to the reference software build to identify areas of the current software build that have been modified with regard to the reference software build (Fig. 7, paragraph 0076); and
  - selecting a focused test suite from a master test suite according to the identified areas, such that a test in the focused test suite, when executed, will exercise at least one identified area of the current software build that has been modified with regard to the reference software build (Figs. 3b, and 7, paragraph 0077).

**Per Claim 2:**

Ousterhout discloses

- generating information identifying areas of the current software build that have been modified with regard to the reference software build that cannot be exercised by at least one test in the master test suite (Fig. 3b, paragraph 0077).

**Per Claim 3:**

Ousterhout discloses

- the current software build is compared to the reference software build according to the modification dates of corresponding source files found in both the current software build and the reference software build (the "last modified" timestamp, Fig. 7, paragraph 0076, lines 4-14).

**Per Claim 4:**

Ousterhout discloses

- the current software build is compared to the reference software build by comparing the executable codes for a routine found in both the current software build and the reference software build (Figs. 3a, and 4a, paragraph 0039, lines 2-12).

**Per Claims 5-8:**

These are the system version of the claimed method discussed above (claims 1-4), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Ousterhout.

**Per Claims 9-12:**

These are another method version of the claimed method discussed above (claims 1-4), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above, including "testing the current software build using the focused test suit (Ousterhout, paragraph 0086)" Thus, accordingly, these claims are also anticipated by Ousterhout.

**Per Claims 13-16:**

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These are another system version of the claimed system discussed above (claims 5-8), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above, including "a test means that exercises the focused test suit on the current software build (Ousterhout, paragraph 0086)". Thus, accordingly, these claims are also anticipated by Ousterhout.

**Per Claims 17-21:**

These are the computer-readable medium version of the claimed method discussed above (claims 9-12), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Ousterhout.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anna Deng whose telephone number is 571-272-5989. The examiner can normally be reached on Monday to Friday 9:30 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Zhen can be reached at 571-272-3708. The fax phone number for the organization where this application or proceeding is assigned is 703-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anna Deng

November 13, 2006

*A. Deng*  
*Mary Stehman*  
*Primary Examiner*  
*11.13.2006*